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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/727,366      | 12/04/2003  | Phillip M. Adams     | 2456.2.6.4          | 6962             |

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| EXAMINER |
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BORISSOV, IGOR N

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3628

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09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                   |  |
|------------------------------|-------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/727,366 | Applicant(s)<br>ADAMS, PHILLIP M. |  |
|                              | Examiner<br>Igor N. Borissov  | Art Unit<br>3628                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 16-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 7/10/2007 is acknowledged and entered. Claims 16-21 have been withdrawn from consideration. Claims 1 and 16 have been amended. Claims 1-21 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata (US 6,321,348).**

Kobata teaches a method for correcting computer hardware and software defects, comprising:

Claim 1,

providing, by a supplier, a product having an embedded defect causing the product to reject operation with a class of associated products for interacting therewith (C. 2, L. 52-62);

discovering the existence of the embedded defect (C. 2, L. 52-62);

disclosing the existence (C. 2, L. 52-62);

repairing the product by enabling operation of the product with the class (C. 3, L. 59-62).

Kobata does not specifically teach that said embedded defect causing the product to reject operation with a class of associated products for interacting therewith, causes the product to *artificially* reject operation with a class of associated products for interacting therewith; and that the *disclosing* step includes disclosing *artificiality*.

However, the fact whether the product rejects operation with a class of associated products artificially or not does not affect the method steps recited.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said embedded defect causing the product to *artificially* reject operation with a class of associated products for interacting therewith, and to modify the disclosing step, because it would advantageously extend the application field of the Kobata system, thereby possibly generate more revenue.

Claim 2. Kobata teaches all the limitations of claim 2, including discovering the existence of the embedded defect over the Internet (C. 3, L. 52-62), except specifically teaching that said disclosing further comprises publicly disclosing.

Official notice is taken that it is old and well known that the use of the Internet include accessing information posted on a Web site.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said disclosing further comprises publicly disclosing, because it would advantageously allow to provide said information to any interested party substantially instantaneously.

Claim 3. Kobata teaches all the limitations of claim 2, including discovering the existence of the embedded defect over the Internet (C. 3, L. 52-62), except specifically teaching that said disclosing further comprises privately disclosing.

Official notice is taken that it is old and well known to encrypt data transmitted over the Internet to provide a secure/private transaction.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said disclosing further comprises privately disclosing, because it would advantageously allow to prevent losses of proprietary information.

Claims 4-8. Same reasoning as applied to claim 1.

Claim 9. Kobata teaches all the limitations of claim 9, including offering, by an independent third party, a solution including installing new software (C. 2, L. 52-62; C. 3,

L. 40-43, 57-58; Fig. 1), except specifically teaching that said offering further comprises offering a license to the solution.

Official notice is taken that it is old and well known to license a software.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said offering further comprises offering a license to the solution, because it would advantageously allow save funds and time by not designing own dedicates software.

**Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata in view of Liability For Product Incompatability and further in view of Moran (US 7,085,936).**

Claim 10. Kobata teaches said method for correcting computer hardware and software defects, comprising:

providing, by a supplier, a product having an embedded defect causing the product to artificially reject operation with a class of associated products for interacting therewith (C. 2, L. 52-62);

discovering the existence of the embedded defect (C. 2, L. 52-62);

disclosing the existence (C. 2, L. 52-62);

repairing the product by enabling operation of the product with the class (C. 3, L. 59-62).

Kobata does not specifically teach that said embedded defect causing the product to reject operation with a class of associated products for interacting therewith, causes the product to *artificially* reject operation with a class of associated products for interacting therewith.

However, the fact whether the product rejects operation with a class of associated products artificially or not does not affect the method steps recited.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include that said embedded defect causing the product to *artificially* reject operation with a class of associated products for

interacting therewith, because it would advantageously extend the application field of the Kobata system, thereby possibly generate more revenue.

Also, Kobata does not specifically teach providing motivation to the supplier; and that said repairing the product is conducted in response to the motivation. Also, Kobata does not specifically teach perceiving a delay in correction of the embedded defect in response to the disclosure.

Liability For Product Incompatibility (Liability) which appears to be published in September 1998, discloses that suppliers who sold products which causes software or hardware incompatibility issues face potentially lawsuits from dissatisfied customers (page 2, lines 1-2), which indicates strong reason for suppliers to fix identified problems timely.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kobata to include providing motivation to the supplier; and that said repairing the product is conducted in response to the motivation, as suggested in Liability, because it would advantageously allow suppliers to avoid financial losses associated with litigation as well as losing customers.

As per perceiving a delay in correction of the embedded defect, it is old and well known fact. For example, Moran discloses that most software vendors, responsible for software vulnerabilities, persistently refuse to fix said vulnerabilities (C. 35, L. 54-56).

Claims 11, 12, 14 and 15. Same reasoning as applied to claim 10.

Claim 13. The fact of infringing software application is old and well known.

### ***Response to Arguments***

Applicant's arguments filed 7/10/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to disclose discovering *artificiality* of the embedded effect, it is noted that claims neither provide a clear definition of the term *artificiality*, nor claims define any link between said term and functionality of the method. Examiner maintains that the method step recited would be

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performed the same regardless the meaning of the word *artificiality*. Accordingly, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation". MPEP 2106 (C).

In response to applicant's argument that Kobata teaches against any action like informing a client his computer problem was artificially embedded *by the supplier*, it is noted that said feature, upon which applicant relies, is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per *disclosing the existence* and artificiality step, Kobata does, in fact, teaches disclosing step. As per *artificiality* feature per se, see arguments above.

In response to applicant's argument that modifying Kobata's reference would "surely infuriate the client and magnify the frustration Kobata seeks to minimize", it is noted that said applicant's argument seems to be conclusory and does not have any evidence to support such a conclusion. Quite contrary, disclosing defects and promptly repairing said defects *regardless* of the *origin* or *nature* of said defects would be greatly appreciated by customers, which will lead to growing of said business.

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

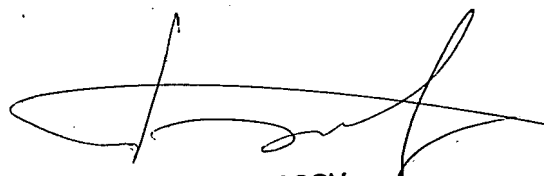
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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09/12/2007



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PRIMARY EXAMINER